

Group Art Unit 1624
Reissue Application No. 09/708,475

November 3, 2004
Attorney Docket No. P25,984-A REI

Remarks

Reconsideration of the Examiner's Action dated June 3, 2004 is requested.

Status of the Claims

The Examiner's Action addressed all of the applicants' pending claims, namely Claims 1 to 48, 50 to 56 and 58 to 115. Claims 1, 9, 30, 31 to 33, 46, 54, 66, 74, 86 to 89, 92, 93, and 96 have been amended. No claims have been added. No claims have been cancelled.

The Examiner's Action

In the Action, all of the outstanding claims were rejected as being based upon a defective reissue oath/declaration. There are no other rejections or objections presented in the Action. With reference to the undersigned's telephone conference with the Examiner on September 24, 2004, the present Reply includes additional claim amendments for the Examiner's consideration prior to the submission of a Supplementary Reissue Declaration.

Amendment to Claims 1, 30, 31 to 33, 46, 66, 86 to 89, 92, 93, and 96

Towards the end of Claim 1, the definition of R₇ is amended in the present Reply from

"R₇ is hydrogen, lower alkyl, or [alkanoyl] acyl;"

to

-- R₇ is hydrogen, lower alkyl, or [alkanoyl] lower alkyl-C(=O)-; --.

The group "lower alkyl-C(=O)" is one of the enumerated groups which fall within the definition of the generic term "alkanoyl" which appears in column 13, lines 26 to 41 of involved U.S. patent No. 5,658,911. This amendment does not broaden the scope of the claim and is consistent with 35 U.S.C. § 251, ¶ 4.

The group "lower alkyl-C(=O)" falls also within the definition of "acyl" which appears in column 13, lines 53 to 60. The subject matter claimed in Claim 1 is within the scope of the disclosure of great-great-great-grandparent Application No. 07/456,790.

Claims 30, 31 to 33, 46, 66, 86 to 89, 92, 93, and 96 are being amended in a similar manner.

Amendments to Claims 9, 54, and 74

The conjunction in the Markush group which appears in the aforementioned three claims has been changed from "or" to --and--.

A Note regarding Claim 33

The definition of Y in Claim 33, column 116, lines 19 and 20 in the printed copy of the involved patent is printed as

"Y is hydrogen, lower alkyl, hydroxy, chlorine, fluorine,
bromine, iodine, lower alkoxy, trifluoromethyl, nitro, or"

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The applicant would like to note that the definition of Y in the claims as originally allowed (see paper 10 of Application No. 08/309,395, dated August 28, 1996) concludes with the term "amino;".¹ Thus patent Claim 33 was printed erroneously due to Patent Office error. Applicants have sought to correct this Patent Office error by amending the definition of Y (see Preliminary Amendment dated November 9, 2000, page 23). It is clear therefore that the addition of the term "amino" does not broaden the claim as originally allowed.

Conclusion

In view of the foregoing claim amendments and remarks, applicants request that the claims be allowed.

In the event any matters remain outstanding, the Examiner is requested to telephone the undersigned at the number listed below.

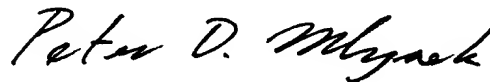
¹Claim 33 in the issued patent was numbered as Claim 321 in paper 10.

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The Commissioner is authorized hereby to charge any fees or credit any overpayment associated with this Reply (copy enclosed) to Deposit Account Number 19-5425.

Respectfully submitted,



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